

REMARKS/ARGUMENTS

Claims 1-8 are pending in the present application. No amendment has been made. Reconsideration of the outstanding rejections is respectfully requested for the following reasons.

Affadavit/Declaration

The Patent Office rejected Applicants' Rule 131 Declaration on the ground that the Declaration did not provide a time line or accounting of activity to show diligence from point of conception to filing of Application. As an initial matter, the period during which Applicants have to show diligence is from just prior to the prior art date of Cheong reference (March 12, 2001) to Applicants' constructive reduction to practice date (March 19, 2001). See MPEP 8th, Rev. 4, page 700-621.

The attached Declaration by Gil Ja Kwon establishes that the Korean application was drafted diligently for the time period between March 12, 2001 - March 18, 2001 and was filed with the Korean Intellectual Property Office on March 19, 2001. The attached Exhibit 1 evidences the email communication between Gil Ja Kwon, who drafted the Korean application, and Applicants, on March 17, 18 and 19, 2001.

Therefore, Applicants submit that the concurrently filed Rule 131 Declaration by Gil Ja Kwon in combination with the previously filed Rule 131 Declaration by Applicants establishes Applicants' prior invention by early conception coupled with constructive reduction to practice accompanied with diligence during the critical period (March 12, 2001-March 19, 2001). Applicants therefore respectfully request withdrawal of the rejections of claims 1-8 based on Finnemore et al. (6,514,557) in combination with Cheong et al. (6,878,420) because Applicants' early invention date removes Cheong as a prior art reference.

Claim rejection - 35 USC 103

In the outstanding Office Action, the Patent Office maintained the previous rejections of claims 1-8 under 35 USC 103(a) as being unpatentable over Finnemore in combination with Cheong, and issued new rejections of claims 1-8 under 35 USC 103(a) as being unpatentable over Finnemore alone.

In the Office Action mailed on October 13, 2004, the Patent Office rejected claim 1, then the only pending claim, under 35 USC 103(a) as being unpatentable over Finnemore alone, and then invited Applicants to supply a showing of unexpected results regarding the criticality of the crystalline state of the substrate. In response, in the amendment filed on February 14, 2005, Applicants pointed out that Applicants' claimed method produced an MgB₂ film of an unexpectedly high critical density, which is approximately 50 times higher than that of Finnemore. In response, in the Office Action mailed on May 4, 2005, the Patent Office withdrew the 103 rejection over Finnemore alone and issued a new 103 rejection over Finnemore in combination with Cheong.

In light of the prosecution summarized above, Applicants do not understand why the Patent Office issued the 103 rejection over Finnemore alone again and requests showing of unexpected results. That rejection was previously withdrawn by the Patent Office because Applicants showed an unexpectedly high critical density of an MgB₂ film produced by the claimed method. See the Office Action mailed on May 4, 2005. In any event, Applicants submit that the unexpectedly high critical density of an MgB₂ film produced by the claimed method makes claims 1-8 patentable over Finnemore alone, and respectfully request withdrawal of the rejections of claims 1-8 over Finnemore alone.

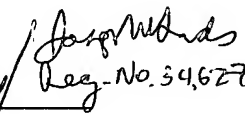
As for the rejections of claims 1-8 over Finnemore in combination with Cheong, the Patent Office responded to Applicants' argument in the last amendment (filed on October 4, 2005) by stating only "Applicant's arguments filed on 10/4/05 have been fully considered but they are not persuasive." The Patent Office did not explain why it found

Applicants' arguments unpersuasive. Without giving any explanation of the reason why finding Applicants' argument unpersuasive, the Patent Office simply repeats the exact same reasoning in the current Office Action as the last one that Applicants traversed.

Applicants believe that the combination of Finnemore and Cheong fails to render obvious claims 1-8 for reasons set forth in Applicants' previous response and will not be repeated here. Furthermore, for reasons set forth above, the Cheong reference has been removed as a prior art reference. Accordingly, the rejection of claims 1-8 over Finnemore in combination Cheong cannot stand and should be withdrawn.

In view of the foregoing, Applicants submit that all pending rejections have been overcome and the present application is in condition for allowance. Therefore, Applicants respectfully request the allowance of the instant application. The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 02-2135.

Respectfully submitted,

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